

### **ELECTION**

Applicant elects, with traverse, what the Examiner has characterized as “Invention I”, deemed drawn to a welding stud, and corresponding to claims 1-17 and 25-29. Additionally, Applicant elects, with traverse, what the Examiner has characterized as “Species I”, deemed drawn to Figs. 3-5, claims 1, 2, 4-11, 13-17 and 25-29 being readable thereon.

### **REMARKS**

Initially, it is noted that this application has been pending for four (4) years, and during that time has had four (4) substantive Office Actions, two (2) Advisory Actions, and two (2) RCE’s. Now, in the course of the last several months, this application has now had two (2) Restriction Requirements, the first being traversed, and is now the subject of a Petition for Supervisory Review – Applicant also seeks examiner reconsideration. The present Restriction Requirement is also erroneous. The fact that this application has already been extensively examined shows that there is no serious burden on the examiner. It is also noted that “RCE” stands for a “Request for *Continued* Examination.” Applicant is entitled to continued examination, not examination anew.

As set forth above, Applicant seeks Examiner reconsideration regarding the previously imposed restriction of Inventions I and II. The Examiner has maintained that the product of Invention I can be made by another and materially different process other than that set forth in Invention II because “the product can be made from casting instead of stamping or etching.” *Restriction Requirement*, September 18, 2007, p. 2. Applicant respectfully disagrees. That is, Applicant believes that the Examiner has failed to show that the product as claimed in Invention I can be made by another materially different process. As called for in Invention I, a welding stud comprises a body having a first and second end, the first end to engage a stud welding gun and the second end being a weld end. The process of Invention II calls for providing a welding stud having a first end and a second end, forming the first end to engage a stud welder, and forming the second end to be entirely welded to a workpiece and with increased resistance to current flow through the second end in the area between a perimeter and a central area of the second end as compared to a welding stud having a nipple and a generally planar surface thereabout. Absent from Invention II, however, is any requirement that the welding stud called for therein be formed by etching or stamping, as the Examiner has asserted. Invention II, as set forth in independent claim 18, does not call for a limitation as to the exact method for forming the welding stud. As such, the process of Invention II, as called for in claim 18, could cover stamping, etching, and

casting processes. The Examiner's asserted limitations applied to Invention II, for requiring formation of the welding stud to be achieved via etching or machining, are only set forth in dependent claims 21 and 22, respectively, and any application of such limitations into independent claim 18 for purposes of restriction is clearly improper. Applicant therefore maintains that the restriction of Inventions I and II is in error and that all claims be rejoined.

Regarding the present Restriction, the Examiner has now, for the first time in four (4) years of examination, identified five alleged 'species' in the pending claims. The Examiner's classification of the 'species' includes Species I consisting of Figs. 3-5, Species II consisting of Figs. 6 and 7, Species III consisting of Figs 8 and 9, Species IV consisting of Figs. 10 and 11, and Species V consisting of Figs. 12 and 13.

In the Restriction Requirement of September 18, 2007, the Examiner stated that "Species I-V are independent or distinct because each include patentably distinct structure." *Restriction Requirement*, supra at 3. Applicant respectfully disagrees with the imposed species restriction and believes the Examiner has not met the required burden for imposing such a restriction.

MPEP §808.01 sets forth that "[a] requirement for restriction is permissible if there is a patentable difference between the species as claimed and there would be a serious burden on the examiner if restriction is not required." The Examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required by showing by appropriate explanation one of the following: a separate classification, a separate status in the art, or a different field of search. *See MPEP §808.02*. In the present case, the Examiner has failed to provide any reasons as to why a serious burden would be imposed if restriction were not required. That is, the Examiner has not shown by appropriate explanation, a separate classification, a separate status in the art, or a different field of search that is required between each of Species I-V. As a basis for restriction, the Examiner has merely stated that "Species I-V are independent or distinct because each include patentably distinct structure." *Restriction Requirement*, supra at 3. No statements have been set forth by the Examiner as to why the "distinct structures" require a separate classification, a separate status in the art, or a different field of search. Therefore, Applicant believes that the Examiner has failed to meet the burden set forth under MPEP §§808.01 and 808.02 for imposing a species restriction.

In issuing the restriction between Species I-V, the Examiner also stated that "[c]urrently, no claims are generic." *Restriction Requirement*, supra at 3. Applicant disagrees. As set forth in MPEP §806.04(d), "[a] generic claim reads on each species illustrated in a patent application." Applicant believes that each of claims 1, 10, 25, 28, and 29 read on at least Species I-IV as

identified by the Examiner and, as such, are each generic to at least Species I-IV. That is, as set forth in MPEP §806.04(d), “[i]n general, a generic claim should require no material element additional to those required by the species claims, and each of the species claims must require all the limitations of the generic claim.” In other words, that which is called for in claims 1, 10, 25, 28, and 29 is generic to that called for in the species claims dependent therefrom. Claims 1, 10, 25, 28, and 29, the generic claims, require “no material element additional to those required by the species claims” as stated in the MPEP.

According to MPEP §806.04(d), “[o]nce a generic claim is allowable, all of the claims drawn to species in addition to the elected species which require all the limitations of the generic claim will ordinarily be allowable over the prior art in view of the allowability of the generic claim, since the additional species will depend thereon or otherwise require all of the limitations thereof.” As such, because Applicant believes claims 1, 10, 25, 28, and 29 to be generic to the scope of material called for in the species claims dependent therefrom, Applicant thereby requests rejoinder of claims 1-29.

For all these reasons, Applicant respectfully requests rejoinder of all claims, of each species. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,

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